

Markman v. Westview

by Charles Shifley and Anthony Bartosik

Markman v. Westview resolved that disputes of patent claim interpretation are for judges of the courts, not juries.¹ Markman did not resolve what procedures are to be used by judges for resolving claim interpretation disputes, what timing is proper for resolving the disputes, or whether all such disputes must actually be resolved.²

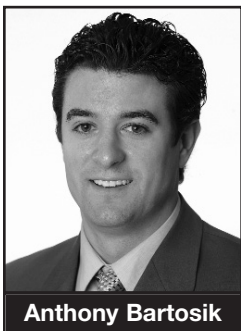


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The Federal Circuit has not filled the gaps, either. According to that court, ‘District courts have wide latitude in how they conduct the proceedings before them, and there is nothing unique about claim construction that requires the court to proceed according to any particular protocol. As long as the trial court construes the claims

to the extent necessary to determine whether the accused device infringes, the court may approach the task in any way that it deems best.’³

In the absence of a controlling rule of law, then, lawyers as well as district judges have become creative. The result must surely be unintended consequences.



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First, of course, within two years of Markman, Markman hearings became common.⁴ Some courts adopted local rules for Markman procedures,⁵ while in other courts; judges adopted their own, varied practices.⁶

But there is more. Markman is now justification for a variety of dissembling, ‘fun and games’ tactics in litigation. Among these

are several that stand out. In this article, the first will be called the ‘ordinary meaning’ tactic, and the second will be called ‘design around’ abuse. These two and several more practices are working deceptions and are muddying the waters of patent law litigation—two more unintended results of Markman.

The ‘Ordinary Meaning’ Tactic

From experience in the courts, the position that patent owner-plaintiffs have begun to assert is that none of the claim terms of patents need interpretation. The owners state that patent claim terms simply have ‘ordinary meaning.’⁷ They rely on Markman’s points that limitations not in dispute need not be interpreted, and

that they may be understood by their ordinary meaning. But the ‘ordinary meaning’ tactic is not simply about easing a court’s interpretation job by narrowing needed interpretations to only a few limitations.

Plaintiffs’ goal, in every patent jury case, is to get to the jury, or at least threaten to get to the jury, so as to provoke a healthy settlement. If successful in reaching a jury, a plaintiff then also wants a jury decision that will stand as against a motion for judgment as a matter of law, or a reversal on appeal. A jury verdict lost to either is of no value, and since claim interpretation decisions, all these years after Markman, are still being reversed at a high rate, plaintiffs have resorted to dissembling measures.

Thus, to avoid any change to or reversal of a jury verdict, some plaintiff-patent owners’ objectives are to avoid a patent claim interpretation of any kind whatsoever, or to at least gain an interpretation as limited as minimally necessary for a plaintiff’s success. These owners view interpretation as a matter of odds: in their view, the fewer claim limitations that are interpreted, the fewer chances there are for post-trial verdict changes or reversals on appeal. These plaintiffs want to stack the odds in their favor and return to pre-Markman days when the jury verdict was a ‘black box’ decision.

Especially among those who are representing the lesser of the ‘patent assertion’ entities, meaning those entities (‘patent trolls’) bringing patent suits solely to prey upon legitimate business entities, the pattern has now emerged that patent owners assert that *each and every* patent claim limitation should be given an ordinary meaning. This is what this article labels the ‘ordinary meaning’ tactic. This tactic appeals to the identified plaintiffs for several reasons. The first one is that asserting ordinary meaning for each and every patent claim limitation takes minimal effort. This seems to be an important factor for a case taken on a contingent fee. Second, the ordinary meaning tactic, if the court is persuaded, allows the plaintiff quicker access to the jury. The case skips a step by not having any patent claim interpretation. Third, and most important, if a court adopts the approach of directing a jury to apply ordinary meaning to all claim limitations, then the ‘black box’ effect of a jury decision is maximized.

The ‘ordinary meaning’ tactic is designed to disguise the true purpose for giving claims their ordinary meaning, for surely all reasonable persons would agree that patent terms in litigation need more than plain-meaning interpretation, or there would hardly be reason for the litigation.

Lawyers, Fun & Games, and Unintended Consequences

The ‘Design Around’ Abuse

An abuse of the *Markman* process also seen in litigation is a lawyer’s tactic this article will refer to as the ‘design around’ abuse. Unlike the ‘ordinary meaning’ tactic, the ‘design around’ abuse has been seen only once, at a distance. But since it worked, it can be expected to spread.

The ‘design around’ abuse relies on misdirecting the patent owner. In a typical patent case, a plaintiff and defendant exchange lists of patent claim terms that they consider to be in need of interpretation. They both proceed. The plaintiff-patent owner relies on the lists in further proceedings, and consistently, prepares a case directed to the disputed limitations. The defendant, meanwhile, does not remain so focused. Instead, the defendant works up a secret position of claim interpretation for *at least one more patent claim limitation than listed*.

The defendant then, for example, cross-examines the plaintiff-patent owner’s claim interpretation expert at a deposition about all the disputed limitations *and the extra limitation(s)*. Unconcerned, perhaps even because the accused infringer may have admitted the extra limitation is present in the accused product, the patent owner lets the expert go forward. Also feeling constrained by the rule that instructions not to answer deposition questions cannot be given just because a matter is not in dispute—see FRCP 30(d)(1)—the patent owner lets the expert testify without interruption. Uninhibited, uninterrupted, and unprepared on interpretation of the undisputed limitation(s), the expert perhaps adopts the defendant’s interpretation on the extra limitation, since he has little or no ability to develop a competing interpretation on the fly.

Once having gained acquiescence to the interpretation of the undisputed limitation, the defendant further lulls the plaintiff-patent owner to sleep by never mentioning the limitation or interpretation again in the current lawsuit.

In this situation of abuse, though, the defendant has carefully selected the additional limitation to be interpreted. It has been selected, not because it has any significance in relation to the accused products, but because it provides a design-around for an already-designed, yet-to-be-implemented, future product.

Once the defendant gains the patent owner’s expert’s favorable interpretation of the additional limitation, then the defendant has gained a ‘safe harbor’ for the future design-around product.

If all else fails, then, the acquiescence of the expert to a defense interpretation in the first case becomes the centerpiece of a defense to a *next* case that the patent owner brings over the *next*, design-around product.

With the patent owner’s expert’s admissions to work with, the defendant can win this second case. This is not far-fetched, in that it happened in the author’s observation, and it was successful.

More Clever and Artful Strategies and Tactics

Not all strategies and tactics in relation to *Markman* are as diabolical as the ‘design around’ abuse. None seem to be as common as the ‘ordinary meaning’ tactic. But here are some others.

The ‘You Go First’ Abuse

A lesser but still-abusive and frequently seen tactic is the effort of patent owners to get courts to adopt Northern-District-of-California-like patent interpretation procedures, but procedures manipulated into variations that are as helpful to the patent owners as possible and as unhelpful to the accused infringers as possible. These efforts typically involve attempts to delete or add steps to the process of patent interpretation set by local rules, to change the timing of the process in the case as a whole, or to re-order or re-jigger the timing of the steps in relation to each other.

The effort, of course, is to minimize the notice that an opponent gets of the abuser’s plans and positions, while maximizing the notice that the abuser gets of the opponent’s plans and positions. An example is a patent owner abusing an alleged infringer. Since a patent owner wins a patent case with any one patent claim that both survives invalidity and is also infringed, the patent owner wants as much information about the accused infringer’s products and the prior art as possible, before stating any position on patent claim interpretation at all.

If the patent owner can ‘thread the needle’ between invalidity and infringement with any one claim, she wins. The manipulation of Northern District of

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California rules might be called the ‘California abuse,’ the ‘thread the needle’ abuse or, perhaps best, the ‘you go first’ abuse.

The ‘Calls for a Legal Conclusion’ Scam

Another thing lawyers now do routinely in patent cases is hide witnesses and whole parties from answering questions that are phrased in the words of patent claims. These days, ask any witness any question using a word that matches a patent claim term, where any abusing lawyer is present, and the lawyer objects that the witness cannot answer. The statement is, ‘Objection. The witness cannot answer the question because the question calls for a legal conclusion.’ Pre-programmed to know what to do when the lawyer says this, the witness answers the question, ‘I’m not a lawyer. I can’t answer that question.’

Sometimes multiple *Markman* abuses are combined.

Thus, the very side in the lawsuit that is saying the patent claim limitations should all carry their ordinary meaning is also a side preventing its witnesses from being asked any question phrased in words that should be understandable by an ordinary meaning.

In any form, this dodging of deposition questions is labeled the ‘calls for a legal conclusion scam.’ It happens all the time. It almost never gets rectified.

The More Artful ‘Examine on Interpretation’ Strategy

One of the more creative, more legitimate, and therefore more ‘artful’ strategies deriving from *Markman* has also seen success. The plaintiff-patent owner having resolved what the patent claim interpretations should be, the owner takes the depositions of the defendant’s representatives about the accused products before the court resolves upon the patent claim interpretation, and even before the parties reveal their claim interpretation positions to each other. To avoid the ‘calls for a legal conclusion scam,’ the plaintiff-patent owner avoids the words of the claims, and asks the deposition witnesses about the accused products *in the words the owner has chosen for the patent claim interpretations*. For example, if a patent claim term in dispute is ‘column,’ and the owner’s interpretation of ‘column’ is ‘element supporting a columnar load,’ the owner does not ask, ‘does the accused product have a column?’ That would only get the ‘calls for a legal conclusion’ objection and avoidance of an answer. Instead, the owner asks, ‘does the accused product have any element that support a columnar load?’

Such a question is not easily avoided, since no reason presents itself for objection.

Assuming the answers to such questions are ‘yes,’ the patent owner then knows that if he can get the court to adopt *his* patent claim interpretations, then he can easily win a summary judgment of infringement. With the issue of infringement being a two-step process, by gaining the desired deposition testimony the patent owner will have won the second step of the process. If the owner can then later win the first step—claim interpretation—the infringement case can be won. Admissions of the representatives of the accused infringer that the accused products have the claim elements, as the elements are interpreted, are the best proof of infringement.

Conclusion: Fun, Games, *Markman*, and Unintended Consequences

Markman was supposed to simplify patent cases. It has complicated them. Beyond adding *Markman* hearings and proceedings, *Markman* has spawned a cottage industry in litigation of lawyers spinning out tactics, abuses, and strategies. Many of these demean *Markman*, the federal courts, and those who practice in patent cases. Some are more artful, but all reflect that no good deed, the

decision of *Markman* included, ever goes unpunished. Or that any action has only its intended consequences.

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Notes

1. *Markman v. Westview Instruments Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 38 USPQ2d 1461 (1996).
2. *Ballard Medical Products v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 60 USPQ2d 1493 (Fed.Cir. 2001).
3. See Ballard, footnote 3.
4. *Cybor Corp. v. FAS Technologies Inc.*, 138 F3d 1448, 46 USPQ2d 1169 (Fed.Cir. 1998)(J. Newman concurring).
5. N.D.Cal.
6. *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 126 F.Supp2d 69, 57 USPQ2d 1449 (D.Mass. 2001)(judge states he decides claim interpretation issues at the summary judgment stage of patent cases).
7. Author Shifley has experienced this several times recently in defending patent infringement cases.

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